

REMARKS

In response to the above-identified Office Action, Applicants amend the application and seek reconsideration thereof. In this response, Applicants amend claims 1, 2 and 8. Applicants do not cancel or add any new claims. Accordingly, claims 1-3 and 6-9 are pending.

I. Claims Rejected Under 35 U.S.C. §112

The Examiner rejects claims 2 and 6-9 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner states claim 2 refers to “X₂Y₂” but there is no “X₂Y₂” in the formula for the compound. The Examiner suggests “X₂Y₂” in claim 2 should read “X₂R₂”. Applicants have amended claim 2 to read “X₂R₂” as the Examiner suggests. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2 and 6-9.

The Examiner rejects claims 8 and 9 stating there is no antecedent basis for “the EL material” as dependent from claims 1 through 3. The Examiner suggests “the EL material” should be changed to “the bisphenylene-spirobifluorene compound”. Applicants have amended claim 8 to read, “the bisphenylene-spirobifluorene compound” as the Examiner suggests. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 8 and 9.

II. Claims Rejected Under 35 U.S.C. §102(b)

The Examiner rejects claims 1 and 6-9 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,840,217 issued to Lupo et al. (“Lupo”). Applicants amend claim 1.

To anticipate a claim, the relied upon reference must disclose every limitation of the claim. Among other elements, amended independent claim 1 defines a bisphenylene-spirobifluorene compound wherein X₁ and X₂ are independently one element selected from the group consisting of C, O, N, S, Si, and Ge. Applicants respectfully submit Lupo fails to teach at least these elements of claim 1.

In making the rejection, the Examiner characterizes Lupo as teaching a branched alkyl group having four carbon atoms, each of X₁ and X₂ containing the elements C, O, and N. See Paper No.

5, page 3. Applicants respectfully submit Lupo does not teach each of X_1 and X_2 being independently one element selected from the group consisting of C, O, N, S, Si, and Ge.

Lupo teaches spiro compounds and their use as electroluminescence materials. See Lupo, col. 1, lines 1-2. Lupo teaches compounds having X_1 similar to the formula set forth in present claim 1, however Lupo teaches X_1 and X_2 containing multiple elements, respectively. See Lupo, entire patent. Therefore, Lupo fails to teach a bisphenylene-spirobifluorene compound wherein X_1 and X_2 are independently one element selected from the group consisting of C, O, N, S, Si, and Ge.

The failure of Lupo to teach each of the elements of claim 1 is fatal to the anticipation rejection. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 1.

Claims 6-9 each depend from claim 1 and contain all the limitations thereof. Therefore, Applicants respectfully submit claims 6-9 are not anticipated by Lupo at least for the same reasons as claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 6-9.

III. Claims Rejected Under 35 U.S.C. §103(a)

The Examiner rejects claims 1-3 and 6-9 under 35 U.S.C. § 103(a) as being obvious over Lupo. Applicants amend claim 1.

To establish a *prima facie* case of obviousness, the prior art must teach or suggest all of the claim limitations. See MPEP § 2143.03; see also In re Royka, 490 F.2d 981; 180 USPQ 580 (CCPA 1974). Independent claim 1 defines a bisphenylene-spirobifluorene compound shown in the figure included in claim 1 wherein R_1 and R_2 are independently a straight-chain or branched alkyl and are independently one element selected from the group consisting of C, O, N, S, Si, and Ge. Applicants respectfully submit Lupo in view of the ordinary skill in the art at the time of the invention does not render independent claim 1 obvious.

In making the rejection, the Examiner asserts it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to make compounds similar to the specific compounds disclosed by Lupo in order to provide other spiro compounds suitable for use as EL

materials in EL devices. See Paper No. 5, page 4. However, in making this assertion, the Examiner does not point to any reference to be combined with Lupo to support the Examiner's position.

Applicants respectfully traverse the Examiner's assertion regarding the ordinary skill in the art at the time of the invention and request the Examiner to provide Applicant with a prior art reference which the Examiner believes can be combined with Lupo to teach each of the elements of claim 1.

In addition, Applicants respectfully submit that one of ordinary skill in the art at the time of the invention would not have had the proper motivation to modify Lupo to read on each of the elements of claim 1. Claim 1 recites R_1 and R_2 are independently a straight-chain or branched alkyl, and X_1 and X_2 are independently one element selected from the group consisting of C, O, N, S, Si, and Ge. Lupo only teaches aromatic structures wherein X_1 and X_2 contain multiple elements, whereas claim 1 recites a straight-chain or branched alkyl wherein X_1 and X_2 contain a single element. One of ordinary skill in the art knows that, by definition, an aromatic structure is not equivalent to a straight-chain or branched alkyl. Hence, there was no motivation at the time of Applicants' invention to modify Lupo's aromatic structure to read on the straight-chain or branched alkyl elements in claim 1. Therefore, Lupo in view of the skill of one of ordinary skill in the art fails to teach or suggest each of the elements of claim 1.

The failure of the prior art to teach or suggest each of the elements of claim 1 is fatal to the obviousness rejection. Thus, claim 1 is not obvious over Lupo in view of the ordinary skill in the art. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 1.

Claims 2-3 and 6-9 each depend from claim 1 and contain all the limitations thereof. Therefore, claims 2-3 and 6-9 are not obvious over Lupo at least for the same reasons as independent claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2-3 and 6-9.



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CONCLUSION

In view of the foregoing, it is believed that all claims now pending (1) are in proper form, (2) are neither obvious nor anticipated by the relied upon art of record, and (3) are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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Dated: _____

10/16/03

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CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope with sufficient postage addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on 10/16/03.

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Date

10/16/03